

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed August 3, 2007. Claims 1-30 were pending in the Application. In the Office Action, Claims 1-30 were rejected. Thus, Claims 1-30 remain pending in the Application. Applicants respectfully request reconsideration and favorable action in this case.

In the Office Action, the following actions were taken or matters were raised:

SPECIFICATION OBJECTIONS

The specification was objected to for informalities. Applicants have amended paragraph [0013] of the specification to correct an incorrect reference numeral 65. Applicants respectfully submit that no new matter has been added by the amendment. Therefore, Applicants respectfully request that this objection be withdrawn.

SECTION 103 REJECTIONS

Claims 1, 3-13, 15, 17-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,452,694 issued to Eisenberg et al. (hereinafter "*Eisenberg*") in view of U.S. Patent Publication No. 2004/0212658 issued to Otsuki (hereinafter "*Otsuki*"). Claims 2 and 14 were rejected under 35 USC §103(a) as being unpatentable over *Eisenberg* in view of U.S. Patent Publication No. 2004/0212658 issued to *Otsuki* and further in view of U.S. Patent Publication No. 2004/00719222 issued to McCarthy et al. (hereinafter "*McCarthy*"). Claim 16 was rejected under 35 USC §103(a) as being unpatentable over *Eisenberg* in view of *Otsuki* and further in view of U.S. Patent Publication No. 2003/0067631 issued to Kinjo (hereinafter "*Kinjo*"). Applicants respectfully traverse these rejections.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's

disclosure. *Id.* Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Additionally, not only must there be a suggestion to combine the functional or operational aspects of the combined references, but also the prior art is required to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 F.2d 1173, 1183 (Fed. Cir. 1991). Moreover, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000).

Eisenberg in view of Otsuki: Claims 1, 3-13, 15, 17-30

Claims 1, 3-13, 15, 17-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Eisenberg* in view of *Otsuki*. Applicants respectfully traverse this rejection.

Of the rejected claims, Claims 1, 11, 20, and 26 are independent. Claim 1 recites “a graphics application executable by a processor, the graphics application adapted to print image graphics data in a print area of a media object, the graphics application adapted to print image notation data to an extension area of the media object” (emphasis added). Applicants respectfully submit that the Examiner has failed to establish a *prima facie* obviousness rejection of Claim 1. For example, in the Office Action, the Examiner appears to admit, and Applicants agree, that *Eisenberg* does not disclose a “graphics application adapted to print image notation data to an extension area of the media object” as recited by Claim 1. (Office Action dated August 3, 2007, page 3). In the Office Action, the Examiner appears to assert that the aforementioned limitation is well-known as purportedly evidenced by *Otsuki*. (*Id.*). Applicants respectfully disagree.

Applicants respectfully submit that *Otsuki* does not remedy the deficiencies of *Eisenberg* and, therefore, is insufficient to support the Examiner's assertion. For example, the portion of *Otsuki* relied on by the Examiner recites:

On platen 26 are disposed an upstream recessed portion 26f and a downstream recessed portion 26r respectively situated upstream and downstream in the sub-scanning direction (see FIG. 1). Upstream recessed portion 26f and downstream recessed portion

26r each extend in the main scanning direction (indicated by arrow MS) over a distance greater than the maximum width of printing paper P useable in printer 22.

(*Otsuki*, paragraph 0080). The cited section of *Otsuki* appears to disclose a printer 22 having a platen 26 larger than the printing paper P, thereby enabling an image to be printed up to the edge of the printing paper P of *Otsuki*. (*Otsuki*, paragraph 0080 and Abstract). *Otsuki* also appears to indicate that the image recording area may be set larger than the area of the printing paper P. (*Otsuki*, paragraph 0088, figure 6). In the Office Action, the Examiner appears to contend that printing in an extension area is well known because "printing can be preformed on the printing medium in portions running out from an intended location." (Office Action dated August 3, 2007). Applicants respectfully disagree.

Claim 1 recites "a print area of a media object" and "an extension area of the media object." Neither *Otsuki* nor *Eisenberg*, alone or in combination, appears to disclose or even suggest both a "print area" of a media object and "an extension area" of the media object. For example, even if the image recording area of *Otsuki* is set to be larger than the paper P of *Otsuki*, Applicants respectfully submit that the image of *Otsuki* appears to still only reside on the print area of the paper P of *Otsuki*. Moreover, even if the purported teaching of *Otsuki*, namely, setting the image recording area larger than the paper, is included in the *Eisenberg* reference, the image content would still only reside on the print area of the *Eisenberg* media object. Thus, the combination of *Eisenberg* and *Otsuki* does not disclose or even suggest all the limitations of Claim 1. Therefore, the Examiner has failed to establish a *prima facie* obviousness rejection of Claim 1. Accordingly, for at least this reason, Applicants respectfully request that the rejection of Claim 1 be withdrawn.

Further, Claim 1 recites "image graphics data in a print area of a media object" and "image notation data to an extension area of the media object" (emphasis added). Neither reference, alone or in combination, appears to disclose or even suggest both "image graphics data" and "image notation data" as recited by Claim 1. Additionally, even if the image recording area of *Otsuki* is set to extend beyond the border of the paper P as purportedly taught by *Otsuki*, only graphics data would be printed onto the media object of *Eisenberg* and, also, the image graphics data would printed only on a print area of the media object. Thus, the combination of *Eisenberg* and *Otsuki* does not disclose or even suggest all the limitations of

Claim 1. Therefore, the Examiner has failed to establish a *prima facie* obviousness rejection of Claim 1. Accordingly, for at least these reasons, Applicants respectfully request that the rejection of Claim 1 be withdrawn.

Claim 11 recites "printing, via the graphics application, the image graphics data to a print area of a media object," and "printing, via the graphics application, the image notation data to an extension area of the media object" (emphasis added). Claim 20 recites "a computer-readable medium having stored thereon an instruction set to be executed, the instruction set, when executed by a processor, causes the processor" to "print the graphics image data to a print area of a media object" and "print the image notation data to an extension area of the media object" (emphasis added). Claim 26 recites "means for printing the graphics image data to a print area of a media object" and "means for printing the image notation data to an extension area of the media object" (emphasis added). At least for the reasons discussed in connection with independent Claim 1, Applicants respectfully submit that Claims 11, 20 and 26 are also patentable over the *Otsuki* and *Eisenberg* references.

Claims 3-10, 12-13, 15, 17-19, 21-25, and 27-30 depend respectively from independent Claims 1, 11, 20, and 26. Thus, at least because Claims 3-10, 12-13, 15, 17-19, 21-25, and 27-30 incorporate the limitations of respective Claims 1, 11, 20, and 26 and also add additional elements that further distinguish the references, Claims 3-10, 12-13, 15, 17-19, 21-25, and 27-30 are also patentable over the references. Therefore, Applicants respectfully request that the rejection of Claims 1, 3-13, 15, 17-30 be withdrawn.

Eisenberg in view of Otsuki and McCarthy: Claims 2 and 14

Claims 2 and 14 were rejected under 35 USC §103(a) as being unpatentable over *Eisenberg* in view of *Otsuki* and further in view of *McCarthy*. Applicants respectfully traverse this rejection.

Claims 2 and 14 depend from respective independent Claims 1 and 11. As shown above, Claims 1 and 11 are patentable over *Eisenberg* in combination with *Otsuki*. The Examiner does not rely on *McCarthy* to remedy, nor does *McCarthy* appear to remedy, the deficiencies of *Eisenberg* and *Otsuki*. Therefore, Claims 2 and 14 are also patentable over the references. Accordingly, Applicants respectfully request that the rejection of Claims 2 and 14 be withdrawn.

Eisenberg in view of Otsuki and Kinjo: Claim 16

Claim 16 was rejected under 35 USC §103(a) as being unpatentable over *Eisenberg* in view of *Otsuki* and further in view of *Kinjo*. Applicants respectfully traverse this rejection.

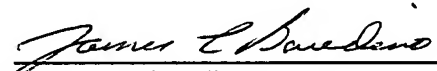
Claim 16 depends from respectively independent Claim 11. As shown above, Claim 11 is patentable over *Eisenberg* in combination with *Otsuki*. The Examiner does not rely on *Kinjo* to remedy, nor does *Kinjo* appear to remedy, the deficiencies of *Eisenberg* and *Otsuki*. Therefore, Claim 16 is also patentable over the references. Accordingly, Applicants respectfully request that the rejection of Claim 16 be withdrawn.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

No fee is believed due with this Response. If, however, Applicants have overlooked the need for any fee due with this Response, the Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this Response to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

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